



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,247	04/16/2004	Luc Phu Tran	2060-3-78	9621

35884 7590 11/22/2005

LEE, HONG, DEGERMAN, KANG & SCHMADEKA, P.C.
801 SOUTH FIQUEROA STREET
14TH FLOOR
LOS ANGELES, CA 90017

EXAMINER

MANOHARAN, MUTHUSWAMY GANAPATHY

ART UNIT	PAPER NUMBER
----------	--------------

2683

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/826,247	TRAN ET AL.	
	Examiner	Art Unit	
	Muthuswamy G. Manoharan	2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant recites in claim 13, "message from the **terminating device to the terminating device** using a text messaging service". It is unclear not why the message has to be delivered from the **terminating device to the terminating device**. Since claims 14-16 all depend directly or indirectly on claim 13 they contain the limitations of those claims and therefore are also indefinite.

Correction/clarification required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,7,8,9,11,12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Griffith et al. (hereinafter Griffith) (US 6366651).

Regarding claim 1, Griffith teaches a method of communicating data in a mobile communications network (Col. 3, lines 20-21), the method comprising recording a voice

message for delivery from an initiating device (Col. 2, lines 36-38) to a terminating device, wherein the initiating device and terminating device are configured to communicate over the mobile communications network (item 206 in Figure 2A; Col. 3, lines 32-34); converting the recorded voice message to a text message using a speech-to-text conversion process (item 211 in Figure 2A; Col. 3, lines 32-39); and delivering the text message to the terminating device by way of a text messaging service implemented over the mobile communications network for delivering text messages from the initiating device to the terminating device (items 214-217 in Figure 2A).

Regarding claim 2, Griffith teaches the method of claim 1, wherein the speech-to-text conversion process resides in the initiating device to convert the voice message to the text message (Col. 3, lines 32-39).

Regarding claim 7, Griffith further teaches the method of claim 1, wherein a message mode is defined to indicate that the voice message should be converted to a text message (Col. 2, lines 19-24).

Regarding claim 8, Griffith further teaches the method of claim 7, wherein the message mode is set by a party using the initiating device (Col. 2, lines 19-24).

Regarding claim 9, Griffith further teaches the method of claim 7, wherein the message mode is set by a party, using the terminating device (Col. 2, lines 19-24).

Regarding claim 10, Griffith teaches the method of claim 1, wherein the recorded voice message is deleted after the text message is delivered to the terminating device (Col. 5, lines 60-61; Col. 6, lines 17-18).

Regarding claim 11, Griffith teaches a method of communicating data in a mobile communications network (Col. 3, lines 4-5), the method comprising: recording a voice message for delivery from an initiating device (Col. 2, lines 36-38) to a terminating device, wherein the initiating device and the terminating device are configured to communicate over the mobile communications network (item 206 in Figure 2A; Col. 3, lines 32-34); delivering the voice message to the terminating device over the mobile communications network (items 214-217 in Figure 2A); and converting the recorded voice message to a text message using a speech-to-text conversion process residing on the terminating device (Col. 4, lines 20-25).

Regarding claim 12, Griffith further teaches the method of claim 11 further comprising displaying the text message on the terminating device (Abstract, line 12).

Regarding claim 13, Griffith further teaches the method of claim 11 further comprising delivering the text message from the terminating device to the terminating device (Abstract).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3-6, 17-20 and 25-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Pelaez et al. (hereinafter Pelaez) (US 2004/0013419).

Regarding claim 3, Pelaez teaches a method of communicating data in a mobile communications network (item 106 in Figure 2), the method comprising recording a voice message for delivery from an initiating device (items 102 and 104 in Figure 2) to a terminating device (items 102 and 104 in Figure 2), wherein the initiating device and terminating device are configured to communicate over the mobile communications network (item 106 in Figure 2); converting the recorded voice message to a text message using a speech-to text conversion process (item 114 in Figure 2; Abstract, lines 5-10); and delivering the text message to the terminating device by way of a text messaging service implemented over the mobile communications network for delivering text messages from the initiating device to the terminating device (Abstract, lines 5-10).

Pelaez further teaches in an analogous art, wherein the speech-to-text conversion process resides in the mobile communications network to convert the voice message to the text message (items 106, 112 in Figure 1; items 208, 210, 212 in Figure 2; Paragraph [0005], lines 5-11).

Regarding claim 4, Pelaez further teaches the method of claim 1, wherein the text messaging service is a short messaging service (SMS) (Abstract, line 12).

Regarding claim 5, Pelaez further teaches the method of claim 1, text messaging service is a enhanced messaging service (EMS) (Paragraph [0022], lines 1-8).

Regarding claim 6, Pelaez further teaches the method of claim 1, wherein the text messaging service is a multi-media messaging service (MMS) (Paragraph [0007], lines 1-4; Paragraph [0015], lines 1-7).

Regarding claim 17, Pelaez teaches a communications device comprising means for interfacing (Paragraph [0011], lines 5-8) with a voice recording mechanism (item 114 in Figure 1) to record a voice message for transmission to a first mobile device connected to a mobile communications network (item 106 in Figure 2), and means for choosing for the voice message to be converted to a text message via a speech-to-text conversion process (item 114 in Figure 2; Abstract, lines 5-10), wherein the text message is delivered to the first mobile device (Paragraph [0023], lines 22-23) by way of a text messaging service implemented over the Mobile communications network.

Regarding claim 18, Pelaez further teaches the method of claim 17, wherein the text messaging service is a short messaging service (SMS) (Abstract, line 12).

Regarding claim 19, Pelaez further teaches the method of claim 17, text-messaging service is a enhanced messaging service (EMS) (Paragraph [0022], lines 1-8).

Regarding claim 20, Pelaez further teaches the method of claim 17, wherein the text messaging service is a multi-media messaging service (MMS) (Paragraph [0007], lines 1-4; Paragraph [0015], lines 1-7).

Regarding claim 25, Pelaez teaches a first mobile device (item 102 in Figure 1) configured for communicating data over a mobile communications network (item 106 in Figure 1), the mobile device comprising: a receiver for receiving voice data transmitted over the mobile communications network (Paragraph [0011], lines 5-7); a speech-to-text converter for converting the voice data to text data (Paragraph [0007], lines 1-3; Paragraph [0005], lines 5-10), and a text messaging interface for communicating the text data to a target mobile device over the mobile communications network (Paragraph [0005], line 10).

Regarding claim 26, Pelaez further teaches the mobile device of claim 25, wherein the first mobile device is the target mobile device (Paragraph [0023], lines 3-8).

Claims 21-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Northcutt (US 2004/00176114).

Regarding claim 21, Northcutt teaches a mobile device (item 305 in Figure 1) configured for communicating voice data over a mobile communications network (item 310 in Figure 2), the mobile device comprising a microphone for receiving voice data to be transmitted to a target mobile device over the mobile communications network (Paragraph [0034], lines 1-4), a speech-to-text converter for converting the voice data to text data (Paragraph [0034], lines 5-7); and a text messaging mechanism for transmitting the text data over the mobile communications network to the target mobile device (Paragraph [0035], lines 1-4).

Regarding claim 22, Northcutt further teaches the mobile device of claim 21, wherein the text messaging service is a short messaging service (SMS) (Paragraph [0032], line 4).

Regarding claim 23, Northcutt further teaches the mobile device of claim 21, wherein the text messaging service is an extended messaging service (EMS) (Paragraph [0033], lines 1-8).

Regarding claim 24, Northcutt further teaches the mobile device of claim 21, wherein the text messaging service is a multi-media messaging service (MMS) (Abstract line 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffith (US 6366651) in view of Northcutt (US 2004/0176114).

Regarding claim 14, Griffith teaches all the particulars of the claim except wherein the text messaging service is a short messaging service. However, Northcutt teaches in an analogous art, the method wherein the text messaging service is a short messaging service (item 325 in Figure 3). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to have the method wherein the text messaging service is a short messaging service. This modification is desirable because

it does not interrupt the other party the way a phone call would. A receiving part can discreetly receive a message while in a meeting without causing a disturbance to others in the meeting.

Regarding claim 15, Griffith teaches all the particulars of the claim except wherein the text messaging service is an enhanced messaging service. However, Northcutt teaches in an analogous art, the method wherein the text messaging service is a enhanced messaging service (Paragraph [0033], lines 1-8). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to have the method wherein the text messaging service is a enhanced messaging service. This modification is desirable because it does not interrupt the other party the way a phone call would. A receiving part can discreetly receive a message while in a meeting without causing a disturbance to others in the meeting.

Regarding claim 16, Griffith teaches all the particulars of the claim except wherein the text messaging service is a multi-media messaging service. However, Northcutt teaches in an analogous art, the method wherein the text messaging service is a multi-media messaging service (item 335 in Figure 3). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to have the method wherein the text messaging service is a multi-media messaging service. This modification is desirable because it does not interrupt the other party the way a phone call would. A receiving part can discreetly receive a message while in a meeting without causing a disturbance to others in the meeting.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Griffith also teaches the limitations of the claim 26, wherein the first mobile device is the target mobile device (Col. 6, lines 56-59)

"Voice to text transcription service" recited in the web page (<http://www.idictate.com/press.shtml>) also teaches the limitations of claim 26.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muthuswamy G. Manoharan whose telephone number is 571-272-5515. The examiner can normally be reached on 7:30AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600